



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,502	01/25/2000	Hongyung Zhang	1508.63556	7217

7590

04/07/2004

Patrick G Burns Esq
Greer Burns & Crain Ltd
300 S. Wacker Drive
Suite 2500
Chicago, IL 60606

EXAMINER

DUONG, TAI V

ART UNIT

PAPER NUMBER

2871

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/490,502

Applicant(s)

ZHANG, HONGYUNG

Examiner

Tai Duong

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4,6,10,11 and 14 is/are allowed.
- 6) ☒ Claim(s) 3,5,7,8,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/22/04 has been entered.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the feature “ wherein further in said sub-TFT substrate processing step, *pattern alignment* is performed by *fusing* a fiducial mark provided for each sub-TFT substrate”, as recited in claim 8.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is not consistent with the specification disclosure and the drawings. It is unclear which Embodiments and which figures disclose the feature “ wherein further in said sub-TFT substrate processing step, *pattern alignment* is performed by *fusing* a fiducial mark provided for each sub-TFT substrate”.

Art Unit: 2871

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 5, 7, 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not disclose the embodiments which have the combination of the Fifth Embodiment (claim 1) and the features recited in claims 3, 5, 7, 12 and 13. It is noted that the features, recited in claims 3, 5, 7, 12 and 13 are directed to the First, Second, Third or Fourth Embodiment.

Applicant's remarks have been considered but are not persuasive because Applicant did not point out where in the original disclosure discloses the combinations of the Fifth Embodiment (claim 1) with the First, Second, Third or Fourth Embodiment. For example, as to claim 3, Figs. 23 and 25 drawn to the Fifth Embodiment both disclose same size liquid crystal panels having an image sensor. Nowhere in the original disclosure does it disclose the embodiment having liquid crystal panels having an image sensor with different sizes being formed in the master glass substrate. It is noted that the issue is not whether it is obvious to one skilled in the art to combine the Fifth Embodiment with the features of the First, Second, Third or Fourth Embodiment. The issue is where in the original disclosure (including the drawings) provides support for the

Art Unit: 2871

combinations of the Fifth Embodiment with the First, Second, Third or Fourth Embodiment. As an example for supporting for the examiner's position, assume that the instant claim 1 recites the features A, B and C; and there is a reference discloses the feature A in the First embodiment, the feature B in the Second embodiment and the feature C in the Third Embodiment. The reference is silent or does not disclose that the features A, B and C can be combined with each other. Is the reference a 102 reference (anticipation) with respect to claim 1 since it discloses all the recited features of claim 1 ? No, the reference is not a 102 reference because it does not provide support for the embodiment having the combination of features A, B and C. The same reasons are also applied to Applicant's remarks regarding claims 5, 7, 12 and 13.

Claims 1, 2, 4, 6, 10, 11 and 14 are allowed.

Claim 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 3, 5, 7, 12 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Tai Duong at telephone number (571) 272-2291.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



04/04


TOANTON
PRIMARY EXAMINER